



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appl. No. : 10/801,401
Applicant(s) : Clements, Jehan
Filed : March 15, 2004
TC/A.U. : 3714
Examiner : Nikolai A. Gishnock
Docket No. : 02013-06034
Customer No. : 27171
Title : *Flip-Over Storytelling Book Publishing System, Method,
and Kit*

**MAIL STOP APPEAL BRIEF – PATENTS
COMMISSIONER OF PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450**

**RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF (37 CFR
41.37) AND AMENDED APPEAL BRIEF**

On September 30, 2009, Applicant filed an Appeal Brief respectfully requesting reconsideration and withdrawal of the outstanding rejections of the application. On November 6, 2009, Applicant received a Notification of Non-Compliant Appeal Brief (37 CFR 41.37) (“Notification”) that identified a failure to comply with 37 CFR 41.37(c)(1)(v). Specifically, the Notification stated that the “[s]ummary of claimed subject matter must refer independent claims on appeal to specification by page and line number and to the drawings, if any. Paragraph numbers cannot be used if the original specification was not filed using paragraph numbers.”

Applicant respectfully notes that the Appeal Brief of September 30, 2009 referenced Applicant’s specification by citing to paragraph numbers of the published patent application, rather than the page and line numbers of the specification as originally filed. As a result, Applicant hereby provides an amended Summary of the Claimed Subject Matter 37 CFR 41.379(c)(1)(v) section, which references the original specification as filed by page and line numbers. *See* Exhibit A attached hereto. The amended portion beings on page 8 of the Appeal

Brief. In addition (for the Patent Office's courtesy), Applicant hereby submits a blackline version of the changes to the Summary of the Claimed Subject Matter section of the Appeal Brief. *See* Exhibit B attached hereto.

In light of the amended Appeal Brief section of Exhibit A, Applicant respectfully asserts that the Appeal Brief is no longer defective under 37 CFR 41.37.

Applicant submits that this Response to Notification of Non-Compliant Appeal Brief (37 CFR 41.37) and Amended Appeal Brief is timely, as the statutory date for response expires on December 6, 2009. However, the Commissioner is authorized to charge any additional fees associated with this response and amended appeal brief, or credit any overpayment, to Deposit Account No. 13-3250. Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 13-3250 (Reference No. 02013.06034). This paragraph is intended to be a constructive petition for extension of time in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,
MILBANK, TWEED, HADLEY & MCCLOY LLP

A handwritten signature in black ink, appearing to read 'Blake Reese', with a long horizontal flourish extending to the right.

Blake Reese
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December 2, 2009

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Exhibit A

2. Summary of Independent Claim 21

Independent claim 21 (*Appendix 1*) is directed to a system for producing a storytelling book in accordance with aspects of the present invention that includes a software program in a computer having subroutines (p. 2, lines 2-8, p. 4, lines 13-18). The computer accepts inputs from a user through blank story book screens (p. 2, lines 2-8, p. 3, line 6 to p. 4, line 2, p. 4, lines 13-18, p. 5, lines 6-10, and p. 6, lines 11-15; *Appendix 3* Fig. 1). The computer will automatically generate a cover page for printing on a first leaf's front-side based on user input of title information, author information and one or more images (p. 3, lines 6-8, p. 5, lines 6-22, and p. 8, lines 3-8; *Appendix 3* Fig. 2). The computer will automatically generate a title page for printing on the first leaf's back-side and a second leaf's front-side based on user input of title information, author information and copyright notice information (p. 3, lines 9-12, p. 5, line 17 to p. 6, line 8, p. 8, line 3-8; *Appendix 3* Fig. 3).

The user will create his or her story by inputting images and corresponding text into the blank story book screens (p. 3, line 13 to p. 4, line 2, p. 6, lines 11-15, and p. 7, lines 3-6; *Appendix 3* Fig. 4). The computer will automatically generate a first story page for printing on the second leaf's back-side from the user's inputted images and will automatically enlarge the images to their maximum size that does not overlap the margins (p. 4, line 13 to p. 5, line 5, p. 7, line 16 to p. 8, line 2, p. 8, lines 9-22, p. 9, lines 14-20, and p. 10, lines 3-15). The computer will further automatically generate a second story page for printing on the third leaf's front-side from the user's inputted images and corresponding text and where the images are the same as those contained on the second leaf's back-side (p. 4, line 13 to p. 5, line 5, p. 8, lines 9-22, and p. 10, lines 3-15; *Appendix 3* Fig. 5). When the one or more images and text of the second story page

are printed on the third leaf's front side, the second story page appears in diametric contraposition to the one or more images of the first story page printed on the second leaf's back-side (p. 4, lines 3-12, p. 4 line 19 to p.5, line 5, p. 8, lines 9-22, p. 10, line 16 to p. 11, line 4, and p. 11, line 20 to p. 12, line 2; *Appendix 3* Figs. 5 and 6).

The computer further automatically generates indicia on the title page, and first and second story pages for indicating how to assemble the second story page in diametric contraposition to the first story page (p. 6, lines 9-10, p. 7, lines 7-8, and p. 9, lines 1-13; *Appendix 3* Figs. 3, 4, 5 and 6). The computer also allows the user to print the cover page, the two title pages, and the first and second story pages, wherein the first story page and second story page are printed for binding the second story page in diametric contraposition to the first story page (p. 9, line 21 to p. 11, line 4; *Appendix 3* Fig. 6).

3. Summary of Independent Claim 26

Independent claim 26 (*Appendix 1*) is directed to a method for producing a storytelling book with elements that are substantially similar to independent claim 21 (p. 13, lines 7-22; *Appendix 3* Fig. 7). Differences between independent claims 21 and 26 are that the computer accepts the inputs from the user and prints the cover page, title page, and first and second story pages (whereas in claim 21, the computer *allows* a user to print) (p. 9, line 21 to p. 11, line 4; *Appendix 3* Fig. 6).

4. Summary of Independent Claim 31

Independent claim 31 (*Appendix 1*) is directed to a kit for producing a storytelling book with elements that are substantially similar to independent claim 21 (p. 2, lines 2-8, p. 11, lines 5-13, and p. 13, lines 3-6). A difference between independent claims 21 and 31 is that claim 31 includes a front cover that houses the printed cover page and binds with the printed title page, first story page, second story page, and a back cover (p. 11, lines 5-13, p. 13, lines 3-6).

Exhibit B

2. Summary of Independent Claim 21

Independent claim 21 (*Appendix 1*) is directed to a system for producing a storytelling book in accordance with aspects of the present invention that includes a software program in a computer having subroutines (~~¶¶ 0004~~p. 2, lines 2-8, ~~0018~~p. 4, lines 13-18). The computer accepts inputs from a user through blank story book screens (~~¶¶ 0004~~p. 2, lines 2-8, ~~0014-0016~~p. 3, line 6 to p. 4, line 2, ~~0018~~p. 4, lines 13-18, ~~0020~~p. 5, lines 6-10, and ~~0026~~p. 6, lines 11-15; *Appendix 3* Fig. 1). The computer will automatically generate a cover page for printing on a first leaf's front-side based on user input of title information, author information and one or more images (~~¶¶ 0014~~p. 3, lines 6-8, ~~0020-0022~~p. 5, lines 6-22, and ~~0036~~p. 8, lines 3-8; *Appendix 3* Fig. 2). The computer will automatically generate a title page for printing on the first leaf's back-side and a second leaf's front-side based on user input of title information, author information and copyright notice information (~~¶¶ 0015~~p. 3, lines 9-12, ~~0022-0024~~p. 5, line 17 to p. 6, line 8, ~~0036~~p. 8, line 3-8; *Appendix 3* Fig. 3).

The user will create his or her story by inputting images and corresponding text into the blank story book screens (~~¶¶ 0016~~p. 3, line 13 to p. 4, line 2, ~~0026~~p. 6, lines 11-15, and ~~0029~~p. 7, lines 3-6; *Appendix 3* Fig. 4). The computer will automatically generate a first story page for printing on the second leaf's back-side from the user's inputted images and will automatically enlarge the images to their maximum size that does not overlap the margins (~~¶¶ 0018-0019~~p. 4, line 13 to p. 5, line 5, ~~0033-0035~~p. 7, line 16 to p. 8, line 2, ~~0037-0038~~p. 8, lines 9-22, ~~0042~~p. 9, lines 14-20, and ~~0044-0046~~p. 10, lines 3-15). The computer will further automatically generate a second story page for printing on the third leaf's front-side from the user's inputted images and corresponding text and where the images are the same as those contained on the second leaf's back-side (~~¶¶ 0018-0019~~p. 4, line 13 to p. 5, line 5, ~~0037-0038~~p. 8, lines 9-22, and ~~0044-0046~~p.

10, lines 3-15; *Appendix 3* Fig. 5). When the one or more images and text of the second story page are printed on the third leaf's front side, the second story page appears in diametric contraposition to the one or more images of the first story page printed on the second leaf's back-side (~~¶¶~~ 0017p. 4, lines 3-12, 0019p. 4 line 19 to p.5, line 5, 0037-0038p. 8, lines 9-22, 0047p. 10, line 16 to p. 11, line 4, and 0051p. 11, line 20 to p. 12, line 2; *Appendix 3* Figs. 5 and 6).

The computer further automatically generates indicia on the title page, and first and second story pages for indicating how to assemble the second story page in diametric contraposition to the first story page (~~¶¶~~ 0025p. 6, lines 9-10, 0030p. 7, lines 7-8, and 0039-0040p. 9, lines 1-13; *Appendix 3* Figs. 3, 4, 5 and 6). The computer also allows the user to print the cover page, the two title pages, and the first and second story pages, wherein the first story page and second story page are printed for binding the second story page in diametric contraposition to the first story page (~~¶¶~~ 0043-0047p. 9, line 21 to p. 11, line 4; *Appendix 3* Fig. 6).

3. Summary of Independent Claim 26

Independent claim 26 (*Appendix 1*) is directed to a method for producing a storytelling book with elements that are substantially similar to independent claim 21 (~~¶~~ 0056p. 13, lines 7-22; *Appendix 3* Fig. 7). Differences between independent claims 21 and 26 are that the computer accepts the inputs from the user and prints the cover page, title page, and first and second story pages (whereas in claim 21, the computer *allows* a user to print) (p. 9, line 21 to p. 11, line 4; *Appendix 3* Fig. 6).

4. Summary of Independent Claim 31

Independent claim 31 (*Appendix 1*) is directed to a kit for producing a storytelling book with elements that are substantially similar to independent claim 21 (~~¶¶~~ 0004p. 2, lines 2-8, 0048p. 11, lines 5-13, and 0055p. 13, lines 3-6). A difference between independent claims 21

and 31 is that claim 31 includes a front cover that houses the printed cover page and binds with the printed title page, first story page, second story page, and a back cover (p. 11, lines 5-13, p. 13, lines 3-6).